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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/777,161	02/13/2004	Toshiyuki Masuda	023484-0158	5102

22428 7590 08/19/2005

FOLEY AND LARDNER
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3000 K STREET NW
WASHINGTON, DC 20007

EXAMINER

BINDA, GREGORY JOHN

ART UNIT	PAPER NUMBER
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3679

DATE MAILED: 08/19/2005

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary	Application No. 10/777,161	Applicant(s) MASUDA, TOSHIYUKI	
	Examiner Greg Binda	Art Unit 3679	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 20 July 2005.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-12 is/are pending in the application.
- 4a) Of the above claim(s) 3 and 11 is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1,2,4-10 and 12 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☒ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 13 February 2004 is/are: a) ☐ accepted or b) ☒ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☒ All b) ☐ Some * c) ☐ None of:
1. ☒ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. _____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- * See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|--|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| 3) <input checked="" type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date <u>2/13/04</u> . | 6) <input type="checkbox"/> Other: _____ |

Election/Restrictions

1. Applicant's election without traverse of Species II shown in Figs. 6-9 in the reply filed on July 20, 2005 is acknowledged.
2. Claims 3 & 11 are withdrawn from further consideration pursuant to 37 CFR 1.142(b) as being drawn to a nonelected species, there being no allowable generic or linking claim. Election was made **without** traverse in the reply filed on July 20, 2005.

Drawings

3. The drawings are objected to because reference numerals 8, 10, 10A, 17, 17d are used to identify parts in the first embodiment and then reused to identify modifications of such parts in the second embodiment. Such usage is proscribed. See MPEP § 608.02(e).
4. Corrected drawing sheets in compliance with 37 CFR 1.121(d) are required in reply to the Office action to avoid abandonment of the application. Any amended replacement drawing sheet should include all of the figures appearing on the immediate prior version of the sheet, even if only one figure is being amended. The figure or figure number of an amended drawing should not be labeled as "amended." If a drawing figure is to be canceled, the appropriate figure must be removed from the replacement sheet, and where necessary, the remaining figures must be renumbered and appropriate changes made to the brief description of the several views of the drawings for consistency. Additional replacement sheets may be necessary to show the renumbering of the remaining figures. Each drawing sheet submitted after the filing date of an

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application must be labeled in the top margin as either “Replacement Sheet” or “New Sheet” pursuant to 37 CFR 1.121(d). If the changes are not accepted by the examiner, the applicant will be notified and informed of any required corrective action in the next Office action. The objection to the drawings will not be held in abeyance.

Specification

5. The title of the invention is not descriptive. A new title is required that is clearly indicative of the invention to which the claims are directed. See also item 7 below.
6. The specification is objected to as failing to provide proper antecedent basis for the following claimed subject matter:
 - a. Claim 1 at page 11, lines 8-10 and claim 12 at page 14, lines 1-3: “the second end [of the boot] . . . has an axially leading end”
 - b. Claim 5 at page 12, line 14: “a stepped portion”

Claim Objections

7. The claims are objected to because each is directed to a “uniform” coupling. It seems the word “uniform” appears here not because it was intended, but rather due to a mistake in translation.
8. Claim 5 is objected to because at page 12, line 11, the word “base” should be changed to “cover” in order to agree with the description at page 7, line 14.

Claim Rejections - 35 USC § 102

9. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

10. Claims 1, 2, 5, 6 & 8-10 are rejected under 35 U.S.C. 102(b) as being anticipated by JP 61-117921. Figs. 1-3 show a universal coupling comprising all the limitations of the claims.

11. Claims 1, 2, 4, 8, 9 & 12 are rejected under 35 U.S.C. 102(b) as being anticipated by Herbenar et al, US 3,441,298. Figs. 1-4 show a universal coupling comprising: a torque transmitting unit (see also col. 4, lines 1-5); first and second shafts 11 & 10 that are connected through the torque transmitting unit; a boot 20 covering the torque transmitting unit and having a first end connected to the first shaft 11 and a second end (see “lower end” at col. 2, line 65) connected to the to the second shaft 10, the second end being formed into cylindrical wall that is tightly disposed on a cylindrical portion 26 of the second shaft and has an axially leading end 32; a boot cover 21 disposed on the cylindrical portion of the second shaft to cover the cylindrical wall leaving an annular space (see Fig. 2) there between, the boot cover having an inside end surface (see Fig. 2) that contacts the axially leading end of the cylindrical wall; and an air bleeding passage that communicates the inside of the boot 20 with the outside of the same, the air bleeding passage including a plurality of first grooves 31 formed in an inside surface of the

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cylindrical wall and a second passage 30 that is defined between the axially leading end 32 of the cylindrical wall and the inside end surface of the boot cover 21. Figs. 1 & 2 show the inside end surface is formed with projections 21a that contact the axially leading end 32 to provide a clearance 30 between the inside surface and the axially leading end.

Claim Rejections - 35 USC § 103

12. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

13. Claim 7 is rejected under 35 U.S.C. 103(a) as being unpatentable over JP 61-117921.

Fig. 3 shows the leading lip of the boot cover 24 is formed with effectively one groove, not a plurality of grooves. However, making the leading lip portion with a plurality of such grooves would have been obvious at the time of applicant's invention, since such a modification would have involved a mere duplication of parts. The duplication of parts for a multiplied effect has no patentable significance and is considered well within the purview and obvious to one of ordinary skill in the art. *St. Regis Paper Co. v. Bemis Co., Inc.* 193 USPQ 8, 11 (7th Cir. 1977).

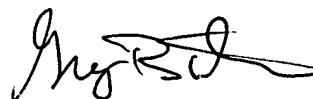
Conclusion

14. The prior art made of record and not relied upon is considered pertinent to applicant's disclosure. Draga shows a universal coupling.

15. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Greg Binda whose telephone number is (571) 272-7077. The examiner can normally be reached on M-F 9:30 am to 7:00 pm with alternate Fridays off.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Daniel P. Stodola can be reached on (571) 272-7087. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

A handwritten signature in black ink, appearing to read 'Greg Binda', with a stylized flourish extending to the right.

Greg Binda
Primary Examiner
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